

REMARKS

Claims 1-10 are pending in the application. Claims 2-5 and 11-72 have been cancelled, claims 1, 6, and 7 have been amended, and claims 73-82 have been added. Support for the amendments to claim 1 can be found in the specification, e.g. on page 11, lines 5-14. Support for new claims 73-82 can be found in the claims as originally found, specifically as follows: claims 73-78 (claims 11-16), claims 79-80 (claims 33-34), and claims 81-82 (claims 55-56).

The specification has also been amended. Support for the amendment on page 23 of the specification, can be found throughout the specification, e.g. on page 24, line 16. The "a" character was formatted into the wrong font, which produced the typographical error. No new matter has been added.

Election Restriction

Applicants acknowledge the Examiner's withdrawal of claims 11-72 from consideration for being drawn to non-elected subject matter. Applicants have cancelled claims 11-72, and reserve the right to pursue the subject matter of these claims in a divisional application.

Specification

Applicants acknowledge the Examiner's typographical corrections, and have amended the specification above to make these changes. Applicants have reviewed the specification and have found no other typographical errors. However, Applicants will amend any errors they find.

Claim Objections

The Examiner has objected to claims 4 and 5 for being directed to non-elected subject matter. These claims have been cancelled so that this objection has been rendered moot.

Double Patenting

Applicant acknowledge the Examiner's concerns for a potential double patenting rejection involving U.S.S.N. 10/219,682 and 10/218,820, and will address this issue once allowable claims have been obtained.

Claims rejections

Rejections under 35 U.S.C. § 112

Written Description

The Examiner has rejected claims 1-10 under 35 U.S.C. § 112, first paragraph for lack of written description. Applicants traverse for the reasons discussed below.

Without acceding to the propriety of the Examiner's position, and in order to expedite prosecution, applicants have amended the claims to recite output arrays resulting from the mating of at least two input arrays, with at least one of the input arrays comprising starting yeast strains of deletion mutants from either *Saccharomyces cerevesiae* or *Schizosaccharomyces pombe* species and another of the input arrays comprising starting yeast strains carrying a genetic alteration linked to a dominant drug resistant marker. Applicants submit that they had possession of the claimed invention at the time the application was filed, as the deletion mutants of *Saccharomyces cerevesiae* and *Schizosaccharomyces pombe* were known to skilled artisans at the time of filing. Since these mutants were known, applicants disclosed relevant identifying characteristics to establish possession of the invention, in accordance with MPEP 2163(ii).

Additionally, applicants have disclosed in the specification sufficient description of a representative number of species, since the application discloses that an output array of the present invention can result from the mating of 8 different strains of yeast carrying a genetic alteration linked to a dominant drug resistant marker with an array of close to 5,000 deletion strains from *Saccharomyces cerevesiae*. Accordingly, applicants submit that the application as originally filed both discloses a representative number of species and discloses relevant identifying characteristics to establish that applicants were in possession of the claimed invention at the time the application was filed. Applicants respectfully request that this § 112 written description rejection be withdrawn.

Indefiniteness

Claims 1-10 have also been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner asserts that recitation of “resulting yeast strain” and “resulting genetic alterations” is indefinite. Without acceding to the propriety of the Examiner’s position, and in order to expedite prosecution, applicants have amended claim 1 to remove the term “resulting” with regard to the yeast strains and genetic alterations. Therefore, Applicants submit that this § 112 indefiniteness rejection has now been rendered moot.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 4, 5 and 7-10 have been rejected for being anticipated by Holzman *et al.* (1993) J. Cell Biol. 122:635-644 (“Holzman”), Ito *et al.* (2000) Proc. Natl. Acad. Sci. USA 97:1143-47 (“Ito”), Uetz et al. (2000) Nature 403:623-7 (“Uetz”), and Uetz et al. (2000) Curr. Opin. Microbiol. 3:303-8 (“Uetz 2000a”). Applicants traverse these anticipation rejections for the reasons discussed below.

The Examiner’s position is that each of Holzman, Ito, Uetz, and Uetz 2000a disclose an output array of multiple **diploid** yeast strains. Applicants have amended claim 1 to recite that the multiple yeast strains in the claimed output array are in the haploid state. The claims as amended recite that the output array results from an intermediate array containing diploid yeast strains, with the diploid yeast strains then undergoing sporulation to result in the output array containing haploid yeast strains. These claim recitations of haploid strains in the output array are not taught by Holzman, Ito, Uetz or Uetz 2000a. In order for a reference to anticipate a claim, the reference must disclose each and every element of the claim. The cited references do not disclose output arrays of **haploid** yeast strains. Applicants submit, therefore, that the claims are not anticipated by Holzman, Ito, and Uetz 2000a. Therefore, Applicants request that this § 102 anticipation rejection be withdrawn.

Applicants: Boone *et al.*
U.S.S.N. 09/930,593

CONCLUSION

Applicants submit that the claims as here amended put the application in condition for allowance, and such action is respectfully requested. Should any questions or issues arise concerning the application, the Examiner is invited and encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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